No. 482.

Brf. of Miller for Petitioner.

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SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1900.

No. 482

CLINTON E. WORDEN & COMPANY,
Petitioner,

vs.

CALIFORNIA FIG SYRUP COMPANY.

PRELIMINARY BRIEF OF PETITIONER

On Application for Writ of Certiorari.

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FILMER-ROLLINS CO. PRINT, 424 Sansome St., S. F.

IN THE

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1900.

CLINTON E. WORDEN & CO.,
Appellant and Petitioner,

vs.

CALIFORNIA FIG SYRUP CO.,
Appellee.

PRELIMINARY BRIEF FOR PETITIONER.

THE FACTS.

This is an application, under section 6 of the Circuit Court of Appeals Act, praying for the issuance of a writ of *certiorari* requiring the Circuit Court of Appeals for the Ninth Circuit to certify to this court for review the case of *Clinton E. Worden & Co., Appellant*, vs. *California Fig Syrup Co., Appellee.*

The California Fig Syrup Co. is a corporation created under the laws of Nevada, and Clinton E. Worden & Co. is a corporation created under the laws of California.

The suit was brought by the appellee in the United States Circuit Court for the Northern District of California against the appellant and certain other parties who were joined with the appellant as defendants.

The object of the suit was to restrain the infringement of a common-law trade-mark consisting of the words "Syrup of Figs" or "Fig Syrup" as applied to a liquid laxative medicine, and also to enjoin the use of certain alleged simulated labels and wrappers, together with an accounting of profits.

The bill of complaint alleged that in 1879 one Richard E. Queen invented a liquid laxative preparation, which consisted of "a combination, in solution, of plants known to be beneficial to the human system, forming an agreeable and effective laxative, to cure habitual constipation and the many ills dependent upon an inactive condition of the liver, kidneys, stomach and bowels," which said remedy, it is alleged, became popular with the public at large and ever since has been sold in great quantities.

It was further alleged that the said Queen adopted as a trade-mark for this medicine the words "Syrup of Figs" or "Fig Syrup," by which name the medicine has always been known; and also that he put up the medicine in a certain style of bottles and wrapped it with a certain label which gave it a distinctive appearance.

This trade-mark, together with the label and the good will of the business, was sold by Mr. Queen to the appellee, a corporation styled "The California Fig Syrup Company," which corporation has ever since been selling the medicine under the said name.

The usual charge of infringement was then made, alleging that the appellant had sold a similar medicine, but of inferior composition, under the name "Syrup of Figs" and "Fig Syrup," put up in bottles and dressed in

labels and wrappers so closely resembling those of the appellee as to deceive the public.

The prayer of the bill was for an injunction to restrain the appellant,

First.—From infringing upon the trade-mark by selling a liquid laxative medicine under the name "Syrup of Figs" or "Fig Syrup."

Second.—From unfair competition in trade by the use of simulated labels and wrappers so closely resembling those of the appellee as to deceive the public, and also from using the words "Fig Syrup Company" as a business name, or any name containing the words "Fig Syrup" or "Syrup of Figs."

In other words, the object of the suit was twofold, viz., to enjoin the infringement of a trade-mark pure and simple and to enjoin unfair competition in trade by reason of simulated labels and wrappers.

The appellee based its cause of action solely upon its common-law rights, no registration of any kind being alleged or relied on, and the ground of jurisdiction in the federal courts was diverse citizenship of the parties.

A preliminary injunction was granted in the case in advance of the final hearing, and is reported in 86 Fed. Rep. 212.

After a final hearing on elaborate proofs the court made an interlocutory decree in favor of the appellee, whereby the appellants were enjoined—

First.—From using the word "Syrup of Figs" and "Fig Syrup" as a trade-mark for a liquid laxative medical compound.

Second.—From simulating the boxes, packages, labels, wrappers, etc., of appellee.

Third.—From using the name "Fig Syrup Company" as a business designation.

The opinion of the lower court will be found reported in 95 Fed. Rep. 132, and the decree rendered will be found at page 574 of the record.

An appeal was prosecuted by the appellant from this decree to the Circuit Court of Appeals for the Ninth Circuit, and after a hearing before that tribunal, said decree was affirmed.

The judges presiding in the Court of Appeals were the Honorables W. B. Gilbert and Erskine M. Ross, Circuit Judges, and Hon. Thomas P. Hawley, District Judge. The decree was affirmed by the votes of Judges Gilbert and Hawley. Judge Ross dissented. This decree will be found at page 645 of the record. The opinion of the Court of Appeals will be found at page 637 of the record and also in 102 Fed. Rep., page 336.

Application is now made to this court for the issuance of the writ of *certiorari*, under section 6 of Circuit Court of Appeals Act, requiring the Court of Appeals for the Ninth Circuit to certify the said case to this Court for review and determination.

The ground of the application is conflict of decision between the different circuit courts of appeal upon the question involved here.

The questions upon which a ruling of this court is desired have been stated by us in the petition as follows:

1. Are the words "Syrup of Figs" and "Fig Syrup," when applied to a liquid, laxative, medical compound, which contains no appreciable quantity of figs or fig juice, misleading or deceptive?

2. Can the words "Syrup of Figs" or "Fig Syrup" be lawfully appropriated as a trade-mark for a liquid laxative medical compound which contains no appreciable quantity of figs or fig juice?

3. Are the words "Syrup of Figs" or "Fig Syrup," when used upon a medicinal preparation to be taken in small doses, and when accompanied by descriptive matter printed upon the package indicating that the medicinal properties claimed for the remedy are not derived from figs, but from the laxative principles of plants known to act most beneficially, calculated to mislead and deceive purchasers to such an extent as to deprive the manufacturer of the right to protection in the exclusive use of said names as a fanciful designation of his product, it being shown that such product in fact contains so little fig juice as to have no appreciable effect, either medicinally or otherwise, and that no such preparation as "Syrup of Figs" is known to the drug trade?

4. Which of the conflicting decisions of the different circuits is correct—that of the Court of Appeals of the Ninth Circuit, holding that the words "Syrup of Figs" or "Fig Syrup" are a lawful trade-mark, or that of the Court of Appeals for the First Circuit and Sixth Circuit holding to the contrary?

5. Is the decree of the United States Court of Appeals for the Ninth Circuit affirming the decree of the United States Circuit Court for the Northern District of California, granting a perpetual injunction against Clinton E. Worden & Co., from making, using, selling, or offering for sale a liquid, laxative medicine under the name of "Syrup of Figs" or "Fig Syrup," good and sound in law?

Put into compact form the controverted question may be stated as follows:

Can the words "Syrup of Figs" be lawfully appropriated as a trade-mark for a laxative medicine which is in fact not a syrup of figs, and not made from figs, but is made from senna and aromatics?

So far as the question of simulation of labels and wrappers is concerned, we care nothing, because that is a matter which can be very easily remedied. The fundamental question which we desire a decision on is the asserted right of the appellee to the words "Syrup of Figs" or "Fig Syrup" as a trade-mark for its medicine, without regard to the character of labels or wrappers upon which it is used, when it is admitted that the medicine has no appreciable quantity of figs or fig juice in it. The appellee asserts that it has a common-law right to those words as applied to its medicine under any and all circumstances, whether the medicine be sold by the aid of labels and wrappers, with the words printed thereon, in their own peculiar style, form, and appearance, or whether the medicine be sold in demi-johns and barrels without any labels and wrappers whatever, providing it is sold by the name "Syrup of Figs" or "Fig Syrup."

This broad contention we most earnestly and emphatically deny, and in support of our contention we assert that the Circuit Courts of Appeals of the First Circuit and of the Sixth Circuit have decided the proposition according to our contention in suits brought by this same California Fig Syrup Company against other infringers. On the other hand the Circuit Court of Appeals for the Ninth Circuit has by the vote of two of its judges, against the dissent of the third, reached an opposite conclusion.

Thus a square conflict has arisen between the two eastern Circuit Courts of Appeals on the one hand and the Western Circuit Court of Appeals on the other. Therefore, in the interest of justice and uniformity of decision to the end that the laws of the United States may be administered uniformly throughout the different states, we make this application for a writ of *certiorari*.

ARGUMENT.

I.

The writ of certiorari is grantable in cases where there is a conflict of decision between two Circuit Courts of Appeal on the same proposition of law.

As we read the decisions of this court there are two general cases in which this writ, so often asked for but so seldom granted, will issue, viz: (1) Cases of peculiar gravity and general importance; (2) Where its issuance is proper in the interest of uniformity of decision.

Instances of the first class may be found in the case of *Law Ow Bew*, 141 U. S. 583, involving a case of international law, and in the case of *In re Fabre*, petitioner, No. 1237 of the October term, 1892, involving important questions as to the rules of navigation.

Instances where this writ was granted in cases of conflict of decision are furnished by *Smith v. Vulcan Iron Works*, and *Norton v. Wheaton*, 165 U. S. 518. In these two cases this court granted the writ because there was a conflict of decision between the Court of Appeals for the Ninth Circuit, and the Court of Appeals of an Eastern Circuit on a question of patent law.

Other cases which may be consulted in this connection are *American Construction Company v. Jacksonville Railroad Company*, 148 U. S. 383; *In re Woods*, 143 U. S. 206.

II.

The facts of this case bring it within the decisions cited above, and show that the writ should issue in the interest of uniformity of decision, because there is a conflict among different Circuit Courts of Appeal on the question of law involved.

At least two circuit courts and two circuit courts of appeal have decided that the words "Syrup of Figs" or "Fig Syrup," as applied by the California Fig Syrup Company to its medicine, cannot be appropriated as a trade-mark. These adjudications proceed on the common sense proposition that the words are either descriptive or else deceptive. If the stuff is really a syrup made from figs, then the words are clearly descriptive. If, on the other hand, it contains no syrup or juice of the fig, or such an infinitesimal amount as to give it no effect, then the words are deceptive and a fraudulent imposition on the public. In neither event can they be lawfully appropriated as a trade-mark.

The first decision rendered in the eastern circuits was that of *California Fig Syrup Company vs. Putnum* (66 Fed. Rep. 750), decided by Judge Colt in the Circuit Court for the District of Massachusetts on March 6, 1895. In deciding the case Judge Colt said:

"If this preparation is in fact a syrup of figs, the words are clearly descriptive, and not the proper subject of a

trade-mark. Upon this point the contention of the plaintiff is that its preparation is not a syrup of figs, since it contains only a very small percentage of the juice of the fig; that the laxative ingredient in it is senna; that while the fig in the form of fruit may have laxative properties arising from the seeds and skin, the fig in the form of a syrup is no more laxative than any other fruit syrup; that it follows from these facts that these words as applied to this compound are not descriptive, but purely fanciful, and therefore constitute a valid trade-mark. The evidence shows that the compound is not a syrup of figs. It might more properly be termed syrup of senna, if the words were intended to be descriptive of the article. But assuming that this is not a syrup of figs, we are met with the inquiry whether these words as applied to this preparation are not deceptive."

The learned judge then proceeds to reproduce in his opinion the familiar cut of the California Fig Syrup Company, consisting of a young lady holding a fig branch in her hand, and quotes from the label used in connection therewith. He then continues his opinion as follows:

"The popularity of this medicine arises from the belief in the minds of the ordinary purchaser that he is buying a laxative compound, the essential ingredient of which is the California fig, whereas, in fact, he is buying a medicine the active property of which is senna. The ethical principle on which the law of trade-marks is based will not permit of any such deception. It may be true, as a scientific fact known to physicians and pharmacists, that the syrup of figs has little or no laxative properties; but this is not the belief of the general public. They purchase this preparation on the faith that it is a laxative compound made from the fruit of the fig,

which is false. This is not an immaterial representation, the effect of which is harmless, but it is a representation which goes to the very essence of the plaintiff's right to a trade-mark in these words. The cases are numerous where the courts have refused to grant relief under these circumstances."

Many of the leading cases are then cited in the opinion, and copious quotations taken therefrom, upon the strength of which authorities the bill was dismissed.

An appeal was taken by the California Fig Syrup Co. in that case to the Circuit Court of Appeals, where the judgment was affirmed by Judges Putnum, Nelson, and Aldrich. The opinion is very short and reads as follows:

"Per CURIAM. We agree with the reasoning and the conclusions of the Circuit Court in this cause, but we do not wish to be understood to approve all the cases cited in its opinion. It is sufficient to refer to Medicine Co. vs. Wood, 108 U. S. 218, and to the underlying principles of Church vs. Proctor, 13 C. C. A. 426, 66 Fed. 240, decided by this court February 2, 1895, as supporting the line of reasoning found in that opinion. The decree of the Circuit Court is affirmed."

California Fig Syrup Co. vs. Putnum, 69 Fed. Rep. 741.

The next case is that of *California Fig Syrup Company vs. Stearns*, 67 Fed. Rep. 1008, decided by District Judge Swan, of the Eastern District of Michigan, on April 1, 1895. It is there said:

"It is apparent from these facts that if the equities of the parties are dependent upon the quantity of fig juice

which enters into their respective preparations, they largely preponderate in favor of defendant. It is equally apparent that complainant makes and sells its wares to the public under the representation that the active and controlling ingredient is derived from the fig, while in fact, under its own proofs, the juice of that fruit has no medicinal value and is lacking in the potency required for a laxative. . . . . The relief prayed by complainant is in truth the privilege of selling its preparation of senna under the name of "Fig Syrup." Whatever the virtues or popularity of complainant's specific, there is no ground on which such relief can be granted."

Consequently, the bill was dismissed. The case was appealed to the Circuit Court of Appeals, and will be found reported in 73 Fed. Rep. 813, where it was affirmed by Judges Taft, Lurton, and Hammond in April, 1896. The opinion was rendered by Judge Taft, and amongst other things he says:

"It may be that no one had ever made a syrup of figs at the time that Queen selected the term to designate the preparation which he put upon the market. That is immaterial. It is entirely possible to describe something by the use of common words which may never have had a commercial use, or which may never have been in fact made. . . . . It is manifest that the term 'Syrup of Figs' used to describe the medical preparation, has a distinct and definite meaning, namely, a combination of sugar and the juice of the fig, and possibly other ingredients, in which, however, the medicinal property of the fig is the active and chief element. . . . . The term 'Syrup of Figs,' therefore, cannot be used as a trade-mark. . . . . But the second ground presented, and that upon which the court below rested its decision, prevents the com-

plainant from having any relief at all. That ground is that the complainant has built up its business and made it valuable by an intentional deceit of the public. It has intended the public to understand that the preparation which it sells has, as an important medicinal agent in its composition, the juice of California figs. This has undoubtedly led the public into the purchase of the preparation. The statement is wholly untrue. Just a suspicion of fig juice has been put into the preparation, not for the purpose of changing its medicinal character, or even its flavor, but merely to give a weak support to the statement that the article sold is syrup of figs. This is a fraud upon the public. It is true it may be a harmless humbug to palm off upon the public as syrup of figs what is syrup of senna, but it is, nevertheless, of such a character that a court of equity will not encourage it by extending any relief to the person who seeks to protect a business which as grown out of, and is dependent upon, such deceit. It is well settled that if a person wishes his trade-mark to be protected by a court of equity, he must come into court with clean hands, and if it appears that the trade-mark for which he seeks protection is itself a misrepresentation to the public, and has acquired a value with the public by fraudulent misrepresentation in advertisements, all relief will be denied to him. This is the doctrine of the highest court of England, and no court has laid it down with any greater stringency than the Supreme Court of the United States. . . . . The argument for complainant is that because fig juice or syrup has no laxative property, everybody ought to understand that when the term is used to designate a laxative medicine it must have only a fanciful meaning. But the fact is admitted that the public believes that fig juice or syrup has laxative medicinal properties. It is to them that the complainant seeks to sell its preparation, and

it is with respect to their knowledge and impressions that the character, whether descriptive or fanciful, of the term used, is to be determined. Exactly this question raised against the same complainant was considered by the circuit court for the district of Massachusetts (Syrup Co. vs. Putnum, 66 Fed. 750), and relief was denied by Judge Colt to the complainant on the ground that its use of the term 'Syrup of Figs' was a misrepresentation to the public, and a fraud upon it. The case was carried to the Court of Appeals, and affirmed upon the opinion of the Circuit Judge."

We thus see that in two circuit courts and in two circuit courts of appeal, and by eight different judges, the views which we have advanced concerning this trade-mark have been sustained, and that this same complainant was not entitled in those circuits to maintain a suit on the same.

The decision of the Court of Appeals for the Ninth Circuit in the case at bar is squarely in conflict with the above cited cases. Said Circuit Court of Appeals for the Ninth Circuit holds that the words "Syrup of Figs" or "Fig Syrup" can be lawfully appropriated as a trade-mark for this medicine because the words are neither descriptive nor deceptive. In rendering the decision they say:

"It is said that the name 'Syrup of Figs' is a false name; that it declares to the public that the preparation is composed of a liquid decoction of figs; that, therefore, it is calculated to deceive the public. It is argued that, if the name does in fact properly designate the preparation, it is not susceptible of appropriation as a trade-mark, and that, if it does not in fact properly desig-

nate the preparation, it is deceptive, and therefore not entitled to protection in a court of equity. *The appellee's medicinal preparation is not a syrup of figs. It is not made from figs, and the quantity of figs used in its preparation is so small that it must be considered to have little, if any, perceptible effect, either in promoting the pleasant taste or otherwise.*

It is shown also that there is known to the drug trade no such preparation as a syrup of figs and that appellee's grantor was the first to use the name. We do not think the name "Syrup of Figs" as applied to the appellee's preparation is in itself calculated to mislead or deceive the public to any material extent. Anyone who knows enough to take medicine when he is ill, must know that a liquid medicine to be taken in small doses as a laxative would be worthless for the purpose intended if it consisted of nothing more than a syrup or decoction of figs. There is in the form in which the medicine is presented, the purpose for which it is used, and the size of the dose which is prescribed, sufficient to charge him with notice that the medicine contains something more than a preparation of figs. And if indeed he be so uninformed and ignorant that the name 'Syrup of Figs' alone conveys to him the impression that the compound is made of figs, there may be found in the carton a distinct intimation to the contrary. It is there declared that the 'remedy presents, in the most acceptable form, the medicinal laxative principles of plants known to act beneficially,' and that the juice of the figs in the combination is only to promote the pleasant taste. As the name 'Syrup of Figs' is so used by the complainant it is a fanciful name only. The equities of the case are not affected either for nor against the appellee by the use of the very small quantity of figs which enter into the preparation of its medicine."

Clinton E. Worden & Co. vs. California Fig Syrup Co.,
102 Fed. Rep., p. 334.

Beyond all cavil this decision of the Court of Appeals for the Ninth Circuit is squarely in conflict with the decisions in the two eastern circuits cited.

It is claimed, however, that the eastern cases presented a different state of facts from the California case. But this alleged difference is more fanciful than real, as will be readily seen by reference to the cases themselves. On the adjoining page will be found a fac-simile of the carton used by the California Fig Syrup Company when the eastern suits were brought and which constituted the foundation for those cases. By glancing at that label, on page 16, it will be seen that it is there stated that,

"Syrup of Figs presents in the most elegant form the laxative and nutritious juice of the figs of California, combined with the medicinal virtues of plants known to be most beneficial to the human system, forming an agreeable and effective laxative to permanently cure habitual constipation and the many ills depending on a weak and inactive condition of the kidneys, liver, stomach, and bowels."

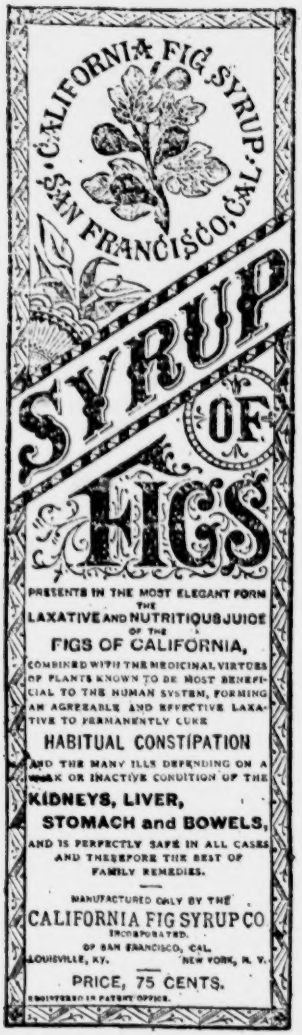
It further appears from the record that upon another label, pasted directly on the bottle enclosed in the carton, appeared the following statement:

"SYRUP OF FIGS.

The California liquid fruit remedy.

Gentle and effective."

OLD LABEL.


CALIFORNIA FIG SYRUP CAL.
SAN FRANCISCO, CAL.
SYRUP
OF
FIGS
PRESENTS IN THE MOST ELEGANT FORM THE
LAXATIVE AND NUTRITIOUS JUICE OF THE
FIGS OF CALIFORNIA,
COMBINED WITH THE MEDICINAL VIRTUES OF PLANTS KNOWN TO BE MOST BENEFICIAL TO THE HUMAN SYSTEM, FORMING AN AGREEABLE AND EFFECTIVE LAXATIVE TO PERMANENTLY CURE
HABITUAL CONSTIPATION
AND THE MANY ILLS DEPENDING ON A WEAK OR INACTIVE CONDITION OF THE
KIDNEYS, LIVER,
STOMACH and BOWELS,
AND IS PERFECTLY SAFE IN ALL CASES AND THEREFORE THE BEST OF FAMILY REMEDIES.
MANUFACTURED ONLY BY THE
CALIFORNIA FIG SYRUP CO
INCORPORATED.
OF SAN FRANCISCO, CAL.
LOUISVILLE, KY. NEW YORK, N. Y.
PRICE, 75 CENTS.
REGISTERED IN PATENT OFFICE.

After the appellee was defeated in its eastern cases, the above-quoted words were erased from the carton and label, and in lieu thereof the following inserted:

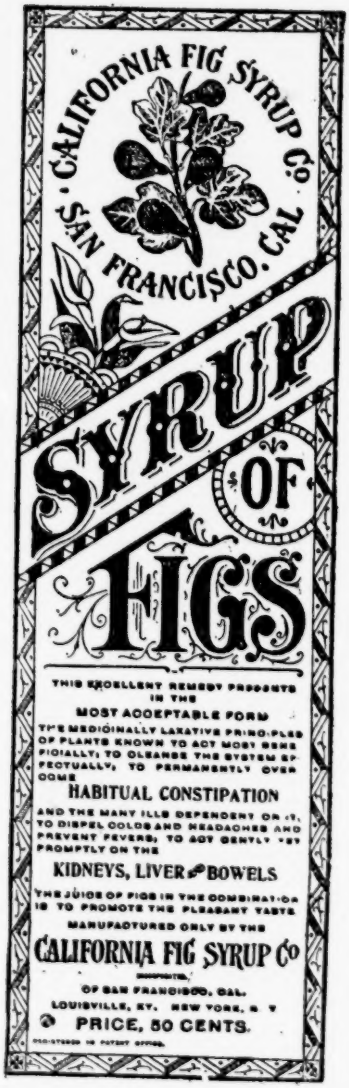
"This excellent remedy presents in the most acceptable form the medicinal laxative principles of plants known to act most beneficially, to cleanse the system effectually, to permanently overcome habitual constipation and the many ills depending on it, to dispel colds and headaches and prevent fevers, to act gently and promptly on the kidneys, liver, and bowels. The juice of figs in the composition is to promote the pleasant taste."

In other words, appellee erased from its interior label the statement that the medicine was a California liquid fruit remedy, and also the direct statement on the outside carton that it contained the laxative and nutritious juice of figs of California, and in place thereof substituted the ambiguous language last quoted above. The new label still contains the words "California Fig Syrup Company, San Francisco, California" surrounding a fig branch bearing the ripe fruit and also the words in bold type, "Syrup of Figs." It still contains the false statement that the medicine overcomes habitual constipation, and there is added to it another false statement that the juice of figs in the composition is to promote the pleasant taste.

It also contains on each end a cut of a young lady holding a fig branch in her hands.

On the next page is a fac-simile of the face of the new label.

NEW LABEL.


CALIFORNIA FIG SYRUP Co.
SAN FRANCISCO, CAL.
SYRUP
OF
FIGS
THIS EXCELLENT REMEDY PRODUCTS IN THE
MOST ACCEPTABLE FORM
THE MEDICINALLY LAXATIVE PRINCIPLES OF PLANTS KNOWN TO ACT MOST BENEFICIALLY, TO CLEANSE THE SYSTEM EFFECTUALLY, TO PERMANENTLY OVERCOME
HABITUAL CONSTIPATION
AND THE MANY ILLS DEPENDENT ON IT, TO DISPEL COLDS AND HEADACHES AND PREVENT FEVERS, TO ACT GENTLY YET PROMPTLY ON THE
KIDNEYS, LIVER & BOWELS
THE JUICE OF FIGS IN THE COMBINATION IS TO PROMOTE THE PLEASANT TASTE.
MANUFACTURED ONLY BY THE
CALIFORNIA FIG SYRUP Co
OF SAN FRANCISCO, CAL.
LOUISVILLE, KY. NEW YORK, N. Y.
PRICE, 50 CENTS.

We maintain that this new label is as fraudulent and deceptive as the old one. The words "Syrup of Figs," as applied to the medicine, in and of themselves indicate that the medicine is made from figs. The Circuit Court of Appeals for the Sixth Circuit said:

"It is manifest that the term 'Syrup of Figs' used to describe a medicinal preparation has a distinct and definite meaning, namely, a combination of sugar and the juice of the fig and possibly other ingredients, in which however, the medicinal property of the fig is the active and chief element." (73 Fed. R. 815.)

This is the plain common sense view to be taken of those words. If any evidence be needed for so simple a proposition, it will be found in the record. (See testimony of Harry N. Gray, p. 380; of Henry E. Hall, p. 391-94; of James Madison Quay, 398-99; of Joseph D. Grant, p. 422; and A. Cheesebrough, p. 425-26; of W. P. Redington, pp. 235, 238, 241; and of J. A. Bright, p. 530-31.)

It is conceded that the appellee's medicine is not a syrup of figs. In deciding the case at bar Judge Gilbert said:

"The appellee's medicinal preparation is not a syrup of figs. It is not made from figs, and the quantity of figs used in its preparation is so small that it must be conceded to have little, if any, perceptible effect either in promoting the pleasant taste or otherwise." (102 Fed. R. 337.)

It is shown by the testimony that the medicine contains but a fraction of one per cent of fig juice, and that

this infinitesimal quantity has no effect whatever on the compound either by way of promoting the pleasant taste or adding any medicinal virtue.

Judge Taft said in the Stearns case, 73 Fed. Rep. 816:

"Just a suspicion of fig juice has been put into the preparation, not for the purpose of changing its medicinal character or even its flavor, but simply to give a weak support to the statement that the article sold is syrup of figs. This is a fraud upon the public."

In view of these facts, we submit that the name "Syrup of Figs" is in and of itself a false assertion, a deceptive term, and a fraud upon the public. This evident intent to deceive is accentuated by the pictures on the labels consisting of fig branches bearing figs, and of young ladies holding fig branches in their hands. Plainly the idea was to convey the impression that the medicine was made from figs.

Again, the new label says that this medicine

"Presents in the most acceptable form the medicinal laxative principles of plants known to act most beneficially to cleanse the system," etc.

What plants are referred to? The only representation of anything in the shape of a plant on the label is the fig branch. There is no statement on this label that the active principle of the medicine is senna. The public is left to infer that the active principle is figs.

And still further, the new label proclaims that the medicine will permanently overcome habitual constipa-

tion. This is a direct and positive falsehood. There is no medicine known to science that will permanently overcome habitual constipation. See testimony of Dr. Kerr (Rec. p. 568) and Dr. Dodge (Id. 556).

These physicians were called for the purpose of showing the falsity of such a contention and they testify squarely to the fact. They were not contradicted, nor was there any attempt at contradiction. Therefore, as the evidence stands, it is an established fact of record that there is no medicine which will permanently overcome habitual constipation, and, consequently, this statement on the new label is a falsehood.

And finally, it is stated on the label that the juice of figs in the composition is to promote the pleasant taste. It will be observed that this language is printed in very small and almost illegible type. Unless a person has unusually good eye sight, he would need the aid of a magnifying glass to decipher it. It is scarcely possible that the purchaser would ever notice it, and even if he did, it is not likely that it would change the impression which had already been produced by the more striking statements and representations on the label tending to induce the belief that the medicine was made from figs.

But even this statement itself is a falsehood. It is not true that the juice of figs in the combination promotes the pleasant taste. There is such an infinitesimal amount of fig juice present that it can neither promote the pleasant taste nor have any other effect. *There is less than one-tenth of one per cent of fig juice in the medicine* (See finding of court in California Fig Syrup Co. v. Stearns, 73 Fed. Rep.

813), and this small quantity has no effect either medicinally or by way of promoting the taste. It cannot be detected. The medicine would be precisely the same both as to effect and as to taste if there were no fig juice in it at all. This is admitted by Mr. Queen, the man who manufactures the medicine. (See Record, pp. 98-9-100-1.)

As was said by Judge Taft, there is just *a suspicion of fig juice* in the preparation, which was put into it, "not for the purpose of changing its medicinal character or even its flavor, but simply to give a weak support to the statement that the article sold is syrup of figs." (73 Fed. R. 816.)

And Judge Gilbert says in the case at bar, "The appellee's medicinal preparation is not a syrup of figs. It is not made from figs, and the quantity of figs used in its preparation is so small that it must be conceded to have little, if any, perceptible effect either in promoting the pleasant taste or otherwise." (Record, 642.)

Thus we see, that according to Mr. Queen, the manufacturer of the medicine, and according to the findings of the Court of Appeals of the Sixth Circuit, through Judge Taft, and the findings of the Court of Appeals of the Ninth Circuit, through Judge Gilbert, there is but an infinitesimal amount of fig juice in this medicine, and the same has no effect whatever either medicinally or by way of promoting the pleasant taste. To put it in the exact language of Judge Gilbert, "the quantity of figs used in its preparation is so small that it must be conceded to have little, if any, perceptible effect either in promoting the pleasant taste or otherwise." It follows conclusively, therefore, in our judgment, that the statement on the

new label relied upon by appellee to repel the charge of fraud, viz., the statement that the juice of the fig is put in to promote the pleasant taste, is itself a false statement. In this new label, therefore, we have the following distinct misrepresentations:

First.—The designation of the medicine as a syrup of figs; whereas, according to Judge Gilbert, it is not a syrup of figs nor made from figs.

Second.—The statement that the medicine overcomes habitual constipation; whereas, according to the medical testimony, that is impossible.

Third.—The statement that the juice of figs in the medicine is to promote the pleasant taste; whereas, according to Mr. Queen, the manufacturer of the medicine, and according to Judge Gilbert in his decision, as well as according to the decisions of the eastern circuits, the small quantity of fig juice in the medicine does not promote the pleasant taste nor does it add anything whatever to the medicine.

The answer which the Court of Appeals in the case at bar made to this obvious proposition is, (1). That the term "Syrup of Figs" is not deceptive, because a person who takes such a medicine must necessarily know that its virtues are not due to fig juice, and (2), If he did not know that fact, then there is to be found on the label a distinct intimation to the contrary which would correct the false impression.

The exact language used by the learned judge who rendered the opinion is as follows:

"We do not think the name 'Syrup of Figs' as applied to the appellee's preparation is in itself calculated to mislead or deceive the public to any material extent. Any one who knows enough to take medicine when he is ill, must know that a liquid medicine to be taken in small doses as a laxative, would be worthless for the purpose intended if it consisted of nothing more than a syrup or decoction of figs. There is in the form in which the medicine is presented, the purpose for which it is used, and the size of the dose which is prescribed, sufficient to charge him with notice that the medicine contains something more than a preparation of figs. And if, indeed, he be so uninformed and ignorant that the name 'Syrup of Figs' alone conveys to him the impression that the compound is made of figs, there may be found in the carton a distinct intimation to the contrary. It is there declared that the remedy presents in the most acceptable form the medicinal laxative principles of plants known to act beneficially and that the juice of the figs in the combination is only to promote the pleasant taste."

Regarding the first part of this answer, it is sufficient for our purpose to state that it is square conflict with the decisions of the other circuits on that precise question. Said Judge Taft, in rendering the decision in the Stearns case, (73 Fed. Rep. 817):

"The argument for complainant is that because fig juice or syrup has no laxative property everybody ought to understand that when the term is used to designate a laxative medicine, it must have a fanciful meaning. But the fact is admitted that the public believes that fig juice

or syrup has laxative medicinal properties. It is to them that the complainant seeks to sell its preparation, and it is with respect to their knowledge and impressions that the character, whether descriptive or fanciful, of the term used, is to be determined."

And Judge Colt said in the Putnum case (66 Fed. Rep. 751):

"It may be true as a scientific fact known to physicians and pharmacists that the syrup of figs has little or no laxative property; but this is not the belief of the general public. They purchase this preparation on the faith that it is a laxative compound made from the fruit of the fig, which is false."

Undoubtedly these views are in conflict with those of the Court of Appeals of the Ninth Circuit in the case at bar.

As to the second answer advanced by the Court of Appeals in this case, viz: That there is a distinct intimation upon appellee's labels that the medicinal properties of its medicine is not due to figs, but that the juice of the fig is only to promote the pleasant taste, we desire to reiterate what we have already said before: *that this statement is in itself a false one, because the juice of the fig does not promote the pleasant taste*, for Judge Gilbert says in his opinion that the quantity used "is so small that it must be conceded to have little, if any, perceptible effect, either in promoting the pleasant taste or otherwise." And furthermore, on this point we desire again to say that, even if this statement were true, it could not in the nature of things correct the false impression conveyed by other

and more prominent representations on the labels due to the name of the article and the representations of fig branches bearing the ripe fruit. These representations, added to the popular impression that figs are laxative, necessarily convey to the mind of the public at large that the laxative principle of this medicine is due to figs.

In this connection it was urged by the appellee's counsel in the Court of Appeals, and will doubtless be urged by him here, that the appellee has published to the world the fact that the basis of its medicine is senna. These advertisements appear to have been inserted mostly in medical journals. It is scarcely possible that the public at large would ever see or read such journals, as they are read mostly by medical men. But irrespective of that, the fact still remains that the labels of the appellee, by which its medicine is sold, do not contain these representations. It is by the labels that the rights of appellee must be gauged, and not by the advertised statements in medical journals disconnected from the labels and the sale of the medicine itself. If a person is selling an article under a fraudulent name, trade-mark, and label, and is enabled to make his sales by reason of such fraud connected directly with the sale of the medicine itself, he cannot be relieved from the charge of fraud in a court of equity by pointing to the fact that he has advertised in certain medical journals of limited circulation statements counteracting the false impression conveyed by the name, trade-mark, and labels of his article. The fraud inheres in the name, trade-mark, and labels themselves as directly connected with the sale of the medicine.

We believe the record shows that the appellee also inserted advertisements in journals and papers other than medical, but, if we remember aright, in those advertisements there was no statement that the active principle of the medicine was senna, except in one or two instances.

Taking all these things together, we assert, without fear of successful contradiction, that this new label is fraudulent and deceptive under the decisions rendered by this and other courts. It would be useless for us, and possibly out of place at this time, to examine and analyze the cases on which we rely. They are so numerous that they would fill a book. But we venture to refer to two which are so aptly in point that they would seem amply sufficient for a correct disposition of the case. We refer to *Brown Chemical Company vs. Meyer*, 139 U. S. 540, and *Schmidt vs. Brieg*, 100 Cal. 673.

The first of these cases involved the use of the words "Brown's Iron Bitters," and it was held by this court that they could not be lawfully appropriated as a trademark because they were so far indicative of the ingredients, characteristics, and purposes of the medicine as to be incapable of lawful appropriation by way of trademark. In other words, they were *ex vi termini* descriptive. This decision was based on the leading cases of

Canal Co. vs. Clark, 13 Wall. 311;

Mfg. Co. vs. Trainer, 101 U. S. 51;

Caswell vs. Davis, 35 N. Y. 281;

Thompson vs. Winchester, 19 Pick. 214;

Raggett vs. Findlater (L. R. 17 Eq. 29).

The second case quoted, *Schmidt vs. Brieg*, 100 Cal. 673, involved the asserted right of appropriating the words "Sarsaparilla and Iron" as applied to a drink. Following the decision of this court in *Brown Chemical Co. vs. Meyer*, above quoted, the Supreme Court of California held that the words "Sarsaparilla and Iron" were in and of themselves so far descriptive that they could not be appropriated as a trade-mark. In answer to that contention the plaintiff in the case argued that his beverage was not made from sarsaparilla and iron, and that it contained such an infinitesimal quantity of sarsaparilla and iron that it did not give to the compound any distinctive characteristic, and, therefore, the name was purely fanciful. This is the precise argument put forth by the California Fig Syrup Company; but the California Supreme Court was not impressed with the argument in that regard and held it to be unsound. In rendering their decision they said:

"But it is claimed by respondents (plaintiffs below) that the words 'Sarsaparilla and Iron' do not, in fact, indicate the character, kind, or quality of their beverage; that it is not a composition of sarsaparilla and iron, but a solution of various substances; that it contains only a small quantity of iron, and the name was given to the beverage only as a name by which it might be known, without in any way being descriptive; but it is sufficient to say in answer to this claim that the name given to the article is either generic, or it is of such a character that it can as well be applied to defendants' beverage as to the plaintiffs."

This clearly expresses the established law on the subject and is based on the leading case of *Manhattan Medicine Co. vs. Wood* (108 U. S. 218). Others of similar import are *The Leather Cloth Case* (4 De Gex J. & S. 137 and 11 H. of L. Cas. 523), *Clotworthy vs. Schepp* (42 Fed. R. 62), *Alden vs. Gross* (25 Mo. App. 123), *Connell vs. Reed* (128 Mass. 477), *Siegert vs. Abbott* (61 Md. 276), *Seabury vs. Grosvenor* (14 Blatchf. 262), *Krauss vs. Peebles* (58 Fed. R. 585), *Mfg. Co. vs. Beeshore* (59 Fed. R. 572), *Fetridge vs. Wells* (13 How. Pr. 385), *Phalon vs. Wright* (5 Phila. 464), *Prince vs. Paint Co.* (135 N. Y. 24).

We do not have to go far to ascertain the reason why the California Fig Syrup Co. desires to convey the impression to the public that its medicine is composed of figs, or at least contains a substantial proportion of fig juice. The record on this subject is clear.

It is a known fact that there is a popular impression amongst people at large that figs have laxative properties. This impression has been known to exist from time immemorial, and is so firmly fixed that this court may possibly take judicial notice of it. But whether this court would take such notice of it or not, the testimony in the case proves it conclusively, for witness after witness testified to the existence of such popular impression. As a matter of fact this popular theory is a false one. Fig juice is not laxative—at least not more so than any fruit juice. The medical men tell us that the seed and the skin of the fig may possibly be slightly laxative, when eaten in large quantities, by reason of the mechanical or grinding action upon the coating of the intestines. Even that is disputed by some medical authorities. But

however that may be, it is conceded by all medical men that fig juice is not laxative. The appellee puts in his medicine no part of the seed or the skin of the fig, but merely an infinitesimal part of its non-laxative juice. The public, however, does not know this. They think that fig juice is laxative, and when they hear the term "Syrup of Figs" used, as applied to a laxative medicine, they naturally conclude that the medicine is made from fig juice, and that it has laxative properties. It was for the purpose of trading upon this popular, but false impression, that Mr. Queen adopted the name "Syrup of Figs." There is no question of this. There can be no other explanation.

In the statement of facts made by Judge Taft in the Stearns case (73 Fed. Rep. 813), we find the following:

"The popular impression that figs are laxative by reason of any medicinal element contained in them is erroneous. Their laxative effect, when eaten in some quantities, is caused by the physical action of the seeds and skin upon the bowels. There is practically no laxative property in the juice of the fig any different from the juice of any other fruit. It has no effect whatever unless taken in quantities as great as that of a pint or a quart."

And Judge Swan, in the same case in the lower court said (67 Fed. R. 1014):

"There can be no doubt, therefore, either that the complainant's preparation is not in fact compounded of the juice of the fig, but its principle is senna, or that its name was adopted and is used for the purpose of trading upon the popular fallacy that the juice of the fig in medic-

inal doses is an effectual remedy for constipation—an impression which is admitted to be without foundation —or that the ordinary purchaser buys the compound as and for the fruit remedy which it is advertised and asserted to be."

The basis of appellee's medicine is the well-known drug called *senna*, which has highly laxative properties. With this Mr. Queen compounds certain aromatic and saccharine substances, which he in his testimony bunches together under the nebulous term "aromatic carminatives." In this way he has produced a laxative medicine, whose basis is *senna*, and has called it by the deceptive term "Syrup of Figs" for the purpose of trading upon the popular but erroneous impression of the public that figs are laxative. All the indicia of the labels tend to show this. The name "Syrup of Figs," the name of the company, "California Fig Syrup Company," the picture of the young lady holding up a fig branch with ripe figs thereon, all support our theory. Mr. Queen could have had no other motive in view than that which we attribute to him. His medicine could more properly be termed a syrup of senna. By no process of honest reasoning can it be called a syrup of figs.

Judge Colt says: "The compound is not a syrup of figs. It might more properly be termed a syrup of senna, etc." (66 Fed. R. 750.)

Judge Taft says, "Just a suspicion of fig juice has been put into the preparation." (73 Fed. R. 816.)

Judge Gilbert says that this medicine "Is not a syrup of figs. It is not made from figs." (102 Fed. R. 337.)

As further showing the intention of appellee in this regard we refer to the testimony of George Alt (Record 326-346-8-9, 350-1, 356-7) who avers that he was one of the incorporators of the California Fig Syrup Co. and president thereof from June, 1882, to October, 1883; that he personally manufactured the medicine in Nevada, under the direction of Mr. Queen, for nearly two years, and was thoroughly familiar with the formula; that no figs whatever were used in the medicine, but Mr. Queen delivered to him an old gunny-sack full of figs and instructed him to expose them to view in the factory so that the public would get the impression that figs were actually used, and in accordance with these orders he did expose the figs to public view.

Now, in view of all these facts, it seems impossible for us to avoid the conclusion that this name is in and of itself a fraudulent representation. Two eastern courts of appeal have squarely so decided. The Court of Appeals of the Ninth Circuit holds otherwise. A conflict has thereby arisen. The appellee may lawfully sell its medicine under this fraudulent name throughout all the states of the Ninth Circuit, and can prevent all other persons from there selling a similar medicine under the same name. It is unlawful in the Ninth Circuit for Clinton E. Worden & Co. to sell their medicine under the name "Syrup of Figs." But outside of and beyond the confines of the ninth circuit it is lawful for him or any other person to manufacture and sell said medicine under the said name. That which is criminal in the ninth circuit is perfectly just and lawful in the other circuits. The law is one thing in the ninth circuit and a different

thing in the other circuits. We submit that, if this state of the law is allowed to stand, it will be a reproach to our judicial system, and this court cannot any too soon interfere and decide between the conflicting theories to the end that uniformity of decision may be established for all the circuit courts of appeals throughout the United States. This is precisely such a case as was contemplated by the framers of the Circuit Court of Appeals Act when they provided by section six that this court, as the supreme judicial tribunal of the land, should have the power to issue writs of *certiorari* to bring up for review cases that had been improperly or improvidently decided by the courts of appeals.

For the reasons hereinabove advanced we respectfully submit that the writ of *certiorari* should be granted in this case in accordance with the prayer of the petition.

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